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09/896,390	06/29/2001	Arturo A. Rodriguez	A-7258	1010

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SCIENTIFIC-ATLANTA, INC.
INTELLECTUAL PROPERTY DEPARTMENT
5030 SUGARLOAF PARKWAY
LAWRENCEVILLE, GA 30044

EXAMINER

LAYE, JADE O

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/896,390

Applicant(s)

RODRIGUEZ ET AL.

Examiner

Jade O. Laye

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

I. Applicant's arguments with respect to all claims have been considered but are moot in view of the new ground(s) of rejection, which is necessitated due to Applicant's amended claims. Accordingly, **THIS ACTION IS MADE FINAL**.

II. Applicant's amendments, dated 9/19/05, have been entered and made of record.

III. Based upon Applicant's amended Claims, the objections applied in the previous Non-Final Action are hereby withdrawn.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

IV. Claims 1-4, 32, 46, 47, and 56 are rejected under 35 U.S.C. 102(e) as being anticipated by *Berstis*. (US Pat. No. 6,564,005).

As to Claim 1, *Berstis* discloses a video recording system comprising a memory for storing content characterizing information, a plurality of portable mediums, and a user interface wherein the user is allowed to request a download. For the sake of clarification, the Examiner considers "characterizing information" of the program to refer to any form of programming data,

such as the specified time period or textual description of the program as shown in Figures 9 and 10. This characterizing information is downloaded because, as shown in Fig. 10, the system will display an archive of recorded programs along with a textual description of said program.

The Examiner interprets the “characterizing info” of the recordable medium to refer to the type of medium specified by the user for downloading. For example, if a dvd is specified for recording, said dvd is “characterized” by the fact the user specified it as the storage medium, as opposed to other mediums on the system. Moreover, the system is further configured to store programs onto the specified medium based upon a correlation between the “characterizing information” of the program and the specified medium. As such, *Berstis* allows the user to specify the channel, day, and time period (i.e., characterizing info) of a program and the type of medium the program is to be downloaded onto (i.e., characterizing info of medium). Once all characterizing info has been identified by the system, the corresponding program is recorded and downloaded onto the medium specified by the user. (Abstract; Col. 2, Ln. 3-14; Col. 6, Ln. 23-65; Col. 8, Ln. 17-29, 57-65 thru Col. 9, Ln. 35; Col. 11, Ln. 2-13; Fig. 8 & 9). Accordingly, *Berstis* anticipates each and every limitation of Claim 1.

Claim 32 corresponds to the system claim 1. Thus, it is analyzed and rejected as previously discussed.

As to Claim 2, *Berstis* further discloses the media characterizing info is organized into a database having multiple fields. (Fig. 10). Accordingly, *Berstis* anticipates each and every limitation of Claim 2.

As to claims 3 and 4, *Berstis* further teaches the characterization info can be stored in the storage device and/or the portable mediums, respectively. (contained in cited portions used to

reject Claim 1). (*Note*: Storing information in the portable mediums, which are located in the storage device, is analogous to storing information in the storage device.) Accordingly, *Berstis* anticipates each and every limitation of claims 3 and 4.

Claims 46 and 47 correspond to the system claims 3 and 4, respectively. Thus, each is analyzed and rejected as previously discussed.

As to Claim 56, *Berstis* further teaches downloading media content in a selected portable medium. (citation portions used under Claim 1). Accordingly, *Berstis* anticipates each and every limitation of Claim 56.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

V. Claims 5-13, 16-25, 27, 29, 30, 33-42, 45, 48, 49, and 51-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Berstis* in view of *Hassell et al.* (US Pat. Pub. No. 2004/0128685).

Claim 5 recites the system of Claim 1, wherein the user interface is configured as a plurality of archive screens. As discussed above, *Berstis* anticipates each and every limitation of Claim 1, but fails to specifically disclose all limitations of Claim 5. However, within the same field of endeavor *Hassell et al* disclose a similar system wherein the interface (i.e., EPG) comprises a plurality of screens. (Pars. [0020 & 0027], Figs. 4-14). Accordingly, it would have been obvious to one having ordinary skill in this art at the time of Applicant's invention to

combine the systems of *Berstis* and *Hassell*, thus providing a system which supplies the user with more detailed information regarding programs stored on the system.

Claim 33 corresponds to the system claim 5. Thus, it is analyzed and rejected as previously discussed.

As to claim 6, *Hassell* further discloses the EPG is pre-configured with categories. (Figs. 5b, 7a, 7b, 13, 16, 18, & 19). Accordingly, the combined systems of *Berstis* and *Hassell* disclose all limitations of Claim 6.

Claim 6 corresponds to the system claim 34. Thus, it is analyzed and rejected as previously discussed.

As to claim 7, *Hassell* further teaches the pre-configured categories can be groups corresponding to media content, genre (i.e. theme), descriptive info, and volumes (i.e., portable mediums). (Pars. [0037, 0056, & 0104]). Accordingly, the combined systems of *Berstis* and *Hassell* disclose all limitations of Claim 7.

Claim 35 corresponds to the method claim 7. Thus, it is analyzed and rejected as previously discussed.

As to claim 8, *Hassell* further teaches the categories can include characterization info and the selections (i.e., programs) which correspond to said characteristics. (Pars. 0037 & 0087)). Accordingly, the combined systems of *Berstis* and *Hassell* disclose all limitations of Claim 8.

Claims 36 and 37 correspond to the method claim 8. Thus, each is analyzed and rejected as previously discussed.

As to claim 9, *Hassell* further teaches the portable mediums are categorized into pre-configured default mediums corresponding to the characterizing info on the recordable content.

To clarify, *Hassell's* "disk one" is categorized into preconfigured default volume medium one (i.e., disk one as shown in Fig. 9), which corresponds to the characterizing information listed in Figures 9 and 10. (Pars. [0056-0059]). Accordingly, the combined systems of *Berstis* and *Hassell* disclose all limitations of Claim 9.

Claim 38 corresponds to the system claim 9. Thus, it is analyzed and rejected as previously discussed.

As to claim 10, *Hassell* further discloses the system displays categories (i.e., categorizes by volumes, themes, etc.) and the user selections within those categories. (Par. [0037 & 0087] & Figs. 4-14). Accordingly, the combined systems of *Berstis* and *Hassell* disclose all limitations of Claim 10.

Claim 39 corresponds to the system claim 10. Thus, it is analyzed and rejected as previously discussed.

As to claims 11 and 12, *Hassell* further teaches the categories and user selections can be displayed in pre-configured and user-defined formats, respectively. (Par. [0037] & Figs. 4-14). Accordingly, the combined systems of *Berstis* and *Hassell* disclose all limitations of Claims 11 and 12.

Claims 40 and 41 correspond to the system claims 11 and 12, respectively. Thus, each is analyzed and rejected as previously discussed.

As to claim 13, *Hassell* further teaches the screen can be configured to allow the user to edit categories (users can label volume/category names) and user selections within the categories. (Pars. [0062, 0063, & 0090]). Accordingly, the combined systems of *Berstis* and *Hassell* disclose all limitations of Claim 13.

Claim 42 corresponds to the system claim 13. Thus, it is analyzed and rejected as previously discussed.

As to claim 16, *Hassell* further teaches the system can comprise of personalized categories. (Par. [0057]). Accordingly, the combined systems of *Berstis* and *Hassell* disclose all limitations of Claim 16.

Claim 45 corresponds to the system claim 16. Thus, it is analyzed and rejected as previously discussed.

As to claim 17, *Hassell* further teaches the user is allowed to transfer media from one storage device to another (i.e., from a device within the subscriber network). (Par. [0081]). Accordingly, the combined systems of *Berstis* and *Hassell* disclose all limitations of Claim 17.

Claim 52 corresponds to the system claim 17. Thus, it is analyzed and rejected as previously discussed.

As to claim 18, *Hassell* further teaches the media can be received from a remote device external to the subscriber network. (Pars. [0016 & 0017]). Accordingly, the combined systems of *Berstis* and *Hassell* disclose all limitations of Claim 18.

Claim 53 corresponds to the method claim 18. Thus, it is analyzed and rejected as previously discussed.

As to claims 19 and 20, *Hassell* further teaches the system is configured to determine if the proper portable medium is loaded and to automatically load the proper medium, respectively. (Par. [0089]). Accordingly, the combined systems of *Berstis* and *Hassell* disclose all limitations of Claims 19 and 20.

Claim 48 corresponds to the system claim 20. Thus, it is analyzed and rejected as previously discussed.

As to claim 21, *Hassell* further teaches the portable mediums can be categorized by titles. (Par. [0086, 0089, & 0090] & Figs. 7a & 13). For example, volume one can be named by the user. Thus, it would be categorized the user's personalized name. Accordingly, the combined systems of *Berstis* and *Hassell* disclose all limitations of Claim 21.

As to claim 22, *Hassell* further teaches the user is allowed to enter a title, thereby prompting the system to identify the medium which corresponds to said title. (Par. [0089]). Accordingly, the combined systems of *Berstis* and *Hassell* disclose all limitations of Claim 22.

As to claim 23, *Hassell* further teaches the system will prompt the user to load the proper medium. (Par. [0089]). Accordingly, the combined systems of *Berstis* and *Hassell* disclose all limitations of Claim 23.

Claim 49 corresponds to the system claim 23. Thus, it is analyzed and rejected as previously discussed.

As to claim 24, *Hassell* further teaches the use of a remote. (Pars. [0019 & 0085] & Fig. 2). Accordingly, the combined systems of *Berstis* and *Hassell* disclose all limitations of Claim 24.

Claim 54 corresponds to the system claim 24. Thus, it is analyzed and rejected as previously discussed.

As to claim 25, *Hassell* further teaches the recordable media and portable media can be categorized by user (i.e., dad's favorite). (Fig. 7b). Accordingly, the combined systems of *Berstis* and *Hassell* disclose all limitations of Claim 25.

As to claim 27, *Hassell* further teaches the use of access locks. (Pars. [0094 & 0099]). Accordingly, the combined systems of *Berstis* and *Hassell* disclose all limitations of Claim 27.

Claim 51 corresponds to the system claim 27. Thus, it is analyzed and rejected as previously discussed.

The limitations of Claim 29 are encompassed by the limitations of Claims 1-5. Accordingly, the combined systems of *Berstis* and *Hassell* disclose all limitations of Claim 29.

As to claim 30, *Hassell* further teaches the system can be located within the set top box. (Pars. [0017-0023]). Accordingly, the combined systems of *Berstis* and *Hassell* disclose all limitations of Claim 30.

Claim 55 is encompassed within the limitations of claim 22. Thus, it is analyzed and rejected accordingly.

VI. Claims 14, 15, 28, 43, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Berstis* in view of *Hassell et al* as discussed under Claim 5, and further in view of *Browne et al.* (WO 92/22983).

Claim 14 recites the system of claim 5, wherein the archive screens are configured to enable the user to search for recordable media among the plurality of portable mediums in the secondary storage device. As discussed above, the combined systems of *Berstis* and *Hassell* disclose all limitations of claim 5, but fail to specifically recite the limitations of claim 14. However, within the same field of endeavor, *Browne et al* disclose a similar system in which the user is allowed to search a program archive via the entry of keywords. (Pg. 30, Ln. 5-27 & Fig. 11). Accordingly, it would have been obvious to one of ordinary skill in this art at the time of

applicant's invention to combine the systems of *Berstis*, *Hassell*, and *Browne* in order to provide a more efficient search engine for the program archive.

Claim 43 corresponds to the system claim 14. Thus it is analyzed and rejected as previously discussed.

Claim 15 recites the system of claim 5, wherein the archive screens are configured to enable the user to search for characterizing information corresponding to the recordable media content among the plurality of portable mediums stored in the secondary storage device. As discussed above, the combined systems of *Berstis* and *Hassell* disclose every limitation of claim 5, but fail to specifically recite the limitations of claim 15. However, *Browne et al* disclose a similar system in which the user is allowed to search a program archive via the entry of keywords. (Pg. 30, Ln. 5-27 & Fig. 11). Accordingly, the combined system of *Berstis*, *Hassell*, and *Browne* disclose all limitations of Claim 15.

Claim 44 corresponds to the system claim 15. Thus, it is analyzed and rejected as previously discussed.

Claim 28 recites the system of claim 27, wherein the authorized access locks have corresponding icons displayed on one of a plurality of screen displays to alert the user to the requirement for authorized access. As discussed above, the combined systems of *Berstis* and *Hassell* disclose each and every limitation of claim 27, but fail to specifically recite the limitation of claim 28. However, *Browne* discloses the use of access lock icons in Figure 6. Therefore, the combined systems of *Berstis*, *Hassell*, and *Browne* contain all limitations of claim 28.

VII. Claims 26 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Berstis* in view of *Hassell et al* as discussed under Claim 25, and further in view of Russo. (US Pat. No. 5,619,247).

Claim 26 recites the system of claim 25, wherein the processor is further configured to select the medium for receiving the downloaded recordable media content corresponding to a user that purchased the recordable media content. As discussed above, the combined systems of *Berstis* and *Hassell* disclose each and every limitation of claim 25, but fail to specifically recite the limitations of claim 26. However, within the same field of endeavor, Russo discloses a similar system whereby individual users have separate storage areas (i.e., mediums). (Col. 11, Ln. 17-30). Therefore, the system selects the medium (which corresponds to purchasing user) in which to download to content. Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine the systems of *Berstis*, *Hassell*, and Russo in order to provide a system whereby individual users could be charged for their own content.

Claim 50 corresponds to the system claim 26. Thus, it is analyzed and rejected as previously discussed.

VIV. Claims 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Hassell et al*.

Claim 31 recites the system of claim 1, wherein the processor, the memory, and the storage device are located in a head end. As discussed above, *Hassell et al* anticipate each and every limitation of claim 1, but fail to specifically recite the limitations of claim 31. However, in view of the disclosure used to reject claim 31 (system can be located at STB), it would be an

obvious design choice to locate the system at the content provider site. Moreover, the Examiner takes Official Notice that it was notoriously known in this art at the time of applicant's invention that systems can be located at the headend. Therefore, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to modify the disclosure of *Hassell*, in order to provide a system located at the head end, thereby supplying cheaper set top box to the consumer.

[Note: The Examiner's Official Notice is evidenced by Russo, U.S. Pat. No. 5,619,247, Col. 3, Ln. 39-Col. 4, Ln. 44, which discloses a similar processor, memory, and storage device located at the cable transmission facility (i.e., headend). Accordingly, this is a specific factual finding predicated on sound technical and scientific reasoning.]

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2617


however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (571) 272-7303. The examiner can normally be reached on Mon. 7:30am-4, Tues. 7:30-2, W-Fri. 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Jade O. Laye
October 13, 2005.



VIVEK SRIVASTAVA
PRIMARY EXAMINER